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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/592,913	11/13/2006	Wendelin Jan Stark	0796-76794/DSD	5717

7590
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03/15/2010

EXAMINER

AHVAZI, BIJAN

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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03/15/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

1. This action is responsive to the amendment filed on March 2, 2010.
2. Claims 1-3, 5-24 are pending. Claim 4 is previously canceled. Claims 25-32 are previously withdrawn as the nonelected invention from further consideration.
3. The rejection of claims 1-3, 5-24 in the last Office action is withdrawn in view of the applicants' argument.
4. Claims 1-3, 5-24 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. (US 10/557,399), in view of Fujii *et al.* (Pat. No. US 4,659,617).

Response to Arguments

5. Applicant's arguments, see Remarks, filed 03/02/2010, with respect to claims 1-3, 5-24 have been fully considered and are persuasive. The rejection of claims 1-3, 5-24 has been withdrawn. However, a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3, 5-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. (US 10/557,399), in view of Fujii *et al.* (Pat. No. US 4,659,617). Although the preambles are different, and the conflicting claims are not identical; they are not patentably distinct from each other because the present claims indicated above also cover compositions which overlap with the claims of the copending applications above, and thus, render the present claims ***prima facie*** obvious. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the method for production of a metal oxide by Stark *et al.* (copending Application No. US 10/557,399), and the metal carboxylate prior to being formed into droplets which has a specific viscosity and the solvent is free of acid with a fibrous product of apatite as taught by Fujii *et al.* in order to find precursors for flame spray synthesis of oxide and metal nanoparticles that combine low viscosity and high metal concentration. Furthermore, such formulations should be readily produced and be stable upon storage. Therefore it would

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have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within generic disclosure with the combination of the prior art as taught by Fujii *et al.* (Col. 4, lines 51-64).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Accordingly, in the view of the above discussion, the request for reconsideration has been considered but **does NOT** place the application in condition for allowance.

Examiner Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijan Ahvazi, Ph.D. whose telephone number is (571)270-3449. The examiner can normally be reached on M-F 8:0-5:0. (Off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from

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a USPTO Customer Service Representative or access to the automated information system,
call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BA/
Bijan Ahvazi,
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Art Unit 1796

/Harold Y Pyon/
Supervisory Patent Examiner, Art Unit 1796

03/12/2010